

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

# PCT

To:

see form PCT/ISA/220

## WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing  
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference  
see form PCT/ISA/220

**FOR FURTHER ACTION**  
See paragraph 2 below

International application No.  
PCT/US2004/004048

International filing date (day/month/year)  
12.02.2004

Priority date (day/month/year)  
14.02.2003

International Patent Classification (IPC) or both national classification and IPC  
C08J5/18, C08L29/04, C08L33/08, B65D65/46

Applicant  
MONOSOL, LLC

### 1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

### 3. For further details, see notes to Form PCT/ISA/220.

**DOCKETED**  
(12/14/04)

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**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/US2004/004048

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**Box No. I Basis of the opinion**

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1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.  
☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material:  
☐ a sequence listing  
☐ table(s) related to the sequence listing
  - b. format of material:  
☐ in written format  
☐ in computer readable form
  - c. time of filing/furnishing:  
☐ contained in the international application as filed.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

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**Box No. II Priority**

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1. ☒ The following document has not been furnished:

☒ copy of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(a)).

☐ translation of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

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**Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

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1. Statement

Novelty (N)	Yes: Claims	1-30
	No: Claims	
Inventive step (IS)	Yes: Claims	
	No: Claims	1-30
Industrial applicability (IA)	Yes: Claims	1-30
	No: Claims	

2. Citations and explanations

see separate sheet

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**Box No. VII Certain defects in the international application**

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The following defects in the form or contents of the international application have been noted:

see separate sheet

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**Box No. VIII Certain observations on the international application**

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The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

**Re Item V**

**Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Reference is made to the following documents:

D1 = WO-A-93/04120

D2 = WO-A-01/11136

D3 = EP-A-0 407 301

2. The subject-matter of claims 1-30 is new in the sense of Article 33(2) PCT.

2.1 The difference between the subject-matter of claim 1 and D1 consists in that D1 does not disclose the particular hydrolysed copolymer of vinyl acetate and methyl acrylate (VAc/MeA) of claim 1 (see search report). This difference establishes the novelty of claim 1 in view of D1.

2.2 The difference between the subject-matter of claim 21 and D2 consists in that D2 does not disclose the casting step (see search report, in particular methods and compositions disclosed on p. 32-34 and comprising samples C9A or C9I and S2-S4). This difference establishes the novelty of claim 1 in view of D2.

2.3 It should be noted that the expression in claim 1 '*for packaging a non-liquid product*' refers to an intended use that does not limit the subject-matter of the claim, this being a film.

3. The subject-matter of claims 1-30 is not inventive in the sense of Article 33(3) PCT.

3.1 The application does not contain evidence showing that the difference of point 2.1 would result in any surprising technical effect being reached.

Thus the technical problem underlying the application may be regarded as to provide just an alternative to the films, packages and unit doses of D1, and the use of the particular VAc/MeA of D2 in order to merely prepare an alternative film (etc.) to D1 should be considered as obvious (see D2, page 22, last paragraph).

It follows that the subject-matter of claims 1-20 cannot be considered as inventive in view of D1 and D2 taken in combination (Art 33(3) PCT).

3.2 The application does not contain evidence showing that the difference of point 3.1 would result in any surprising technical effect being reached.

Thus the technical problem underlying the application may be regarded as to provide just an alternative method to D2, and the use of a casting step, a well known practice in the art (see, eg, D1 or D3), in order to merely provide an alternative to the method of D2 should be considered as obvious.

It follows that the subject-matter of claims 21-30 cannot be considered as inventive in view of D2 and D1 or D3 taken in combination (Art 33(3) PCT).

#### **Re Item VII**

##### **Certain defects in the international application**

1. Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in the documents D1-D3 is not mentioned in the description, nor are these documents identified therein.

#### **Re Item VIII**

##### **Certain observations on the international application**

1. The following terms or expressions are unclear (Art. 6 PCT):

1.1 It is not clear whether the **weight %** mentioned in the claims refers to the film, the monomer or the polymer (etc.). The same applies to the expression **mol percent**, since it is not clear whether they refer to the polymer or to a monomer (etc.)

1.1 The expression **solution viscosity** is also unclear in the claims since a method for its calculation is not included.

1.3 Claims 15-18 claims a product (film) that is defined in terms of a process for its preparation, this being unclear.